



UNITED STATES PATENT AND TRADEMARK OFFICE

ST

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,531	11/28/2000	James F. Young	10271-021-999	7010
20583	7590	04/04/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			CHEN, STACY BROWN	
			ART UNIT	PAPER NUMBER

1648

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/724,531	Applicant(s) YOUNG ET AL.	
	Examiner Stacy B. Chen	Art Unit 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/5/05; 11/23/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment filed January 13, 2006 is acknowledged and entered. Claims 1, 3-5, 179-184, 186, 187, 189, 192, 193, 195, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 280-299, 303 and 305-323 are pending.

Double Patenting

2. The rejection of claim 180 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of US Patent 6,656,467, is withdrawn in view of the terminal disclaimer filed October 5, 2005.

The provisional rejection of claims 3, 180 and 182 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 55-58 of US Patent 6,818,216, is withdrawn in view of the terminal disclaimer filed October 5, 2005.

3. (*New Rejection*) Claims 1, 3, 5, 179, 180, 182, 186, 187, 206, 212, 280-287 and 320-323 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 87, 88 and 90-118 of copending Application No. 10/020,354.

Art Unit: 1648

Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim sets encompass antibodies having SEQ ID NO: 48, 10, 19, 20, 39, 5 and 6.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. On December 15, 2005, a Notice of Allowability for 10/020,354 was mailed to Applicant.

4. The rejection of claim 308 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson (US Patent 5,824,307) is withdrawn in view of Applicant's amendment to claim 308. Claim 308 is now drawn to an isolated antibody comprising a complementarity determining region (CDR) having an amino acid sequence of a variable light (VL) CDR1 or VL CDR2 of the antibody P12F2. Johnson does not teach SEQ ID NO: 21 or 27 (CDR1 and CDR2, respectively).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

(*New Rejection*) Claims 1, 3-5, 179-184, 186, 187, 189, 192, 193, 195, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 280-299, 303 and 305-323 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. All of the claims recite, "having an amino acid sequence". It is unclear whether Applicant intends for the claims to encompass antibodies/compositions/kits comprising the entire sequence that is recited in the claim, or a portion of the sequence. For example, claim 1 could be interpreted two ways: an

Art Unit: 1648

antibody comprising a variable heavy domain having a portion of amino acid sequence of SEQ ID NO: 48, or an antibody comprising a variable heavy domain having the entire amino acid sequence of SEQ ID NO: 48. The claims should be amended to clearly reflect the metes and bounds of the claims. Suggested language is, "An isolated antibody comprising a variable heavy (VH) domain having the amino acid sequence of SEQ ID NO: 48".

Conclusion

6. No claim is allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Stacy B. Chen 3/28/06

Stacy B. Chen
March 28, 2006

Continuation of Disposition of Claims: Claims pending in the application are 1,3-5,179-184,186,187,189,192,193,195,201,204-212,222-227,231-233,241,242,244,245,250,280-299,303 and 305-323.

Continuation of Disposition of Claims: Claims rejected are 1,3-5,179-184,186,187,189,192,193,195,201,204-212,222-227,231-233,241,242,244,245,250,280-299,303 and 305-323.